

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

On 12-23-03

TOWNSEND and TOWNSEND and CREW LLP

By: Karen Karlin



PATENT

Attorney Docket no. 02307K-141313US
Client Ref. no. 96-540-5

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Sawyers *et al.*

Application No.: 10/062,684

Filed: January 30, 2002

For: METHODS OF SIMULATING
HUMAN PROSTATE CANCER
PROGRESSION

Customer No.: 20350

Confirmation No. 4751

Examiner: Thai-An N. Ton

Group Art Unit: 1632

PETITION UNDER 37 CFR §1.47(a)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 CFR §1.47(a), Applicants hereby petition for filing of the above-identified patent application when a joint inventor refuses to sign or cannot be found or reached after diligent effort. Proof of the pertinent facts is submitted herein with the petition, to properly establish that a diligent effort has been made to obtain the signature of joint inventor Dr. Karen A. Klein. Specifically, Applicants are submitting the following items:

Exhibit A: a photocopy of the letter (dated September 19, 2003) accompanying a substitute Combined Declaration and Power of Attorney along with a copy of the subject patent

application and original Combined Declaration Power of Attorney filed in this application that were mailed to Dr. Klein at her last known work address.

Exhibit B: a photocopy of a letter (dated November 5, 2003) accompanying a copy of the substitute Combined Declaration and Power of Attorney that were sent via priority FedEx to her last known home address; copy of FedEx proof of delivery.

Exhibit C: a photocopy of a letter (dated November 13, 2003) accompanying another copy of the substitute Combined Declaration and Power of Attorney that were sent via certified mail to her last known home address; copy of certified mail return receipt postcard.

Exhibit D: a photocopy of a letter (dated November 18, 2003) accompanying a copy of the original Declaration and patent application, along with a pre-paid FedEx envelope for returning the signed substitute Combined Declaration and Power of Attorney.

The Examiner deemed the original Declaration filed in this application as defective and required filing of a compliant Declaration. All of the inventors (Drs. Sawyers, Witte, Reiters, and Klein) signed the combined Declaration and Power of Attorney as originally filed in the application.

A substitute Combined Declaration and Power of Attorney (with copies of the original document and patent application) were sent via first class mail to the inventors at the work addresses at the University of California. Signed substitute Declaration and Power of Attorney documents were received from Drs. Sawyers, Witte, and Reiter. Dr. Sawyers informed the undersigned agent that Dr. Klein no longer worked in his laboratory and he did not have any further information about where she could be contacted.

The last known address of Dr. Klein is 174 Denslow Avenue, Los Angeles, CA 90049. Two attempts were made by Applicant's agents to reach Dr. Klein to obtain her signature on the substitute Declaration at this address. The deliveries to her home address were via Federal Express (see Exhibit B) and via Certified Mail (see Exhibit C), as shown by the evidence submitted herewith. These deliveries were signed for by Sean Turner.

No phone number listing was identified in the Los Angeles phone directory, however, the application owner found a last known home phone number in their files. On November 18, 2003, Applicants' agent spoke to Dr. Klein on the phone. She confirmed that her home address of record was current and that the documents had been received. Subsequent to the conversation, Dr. Klein was sent a copy of the application and the original Declaration/Oath, along with a pre-paid FedEx envelope (Exhibit D). No response has been received.

In view of the foregoing, we petition to proceed without Dr. Klein's signature. The other joint inventors, Drs. Sawyers, Witte, and Reiter, have executed the substitute Combined Declaration and Power of Attorney for the application (enclosed). Because Dr. Klein has not signed the documents after diligent effort, Applicants respectfully request that the above-identified application be filed on behalf of Drs. Sawyers, Witte, and Reiter and the non-signing joint inventor, Dr. Klein, in accordance with 37 CFR §1.47(a).

Please charge fee for filing this petition to our Deposit Account no. 20-1430 in accordance with the accompanying Fee Transmittal PTO/SB/17 submitted in duplicate

Respectfully submitted,



Chuan Gao
Reg. No. 54,111

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 415-576-0200
Fax: 415-576-0300
JML:jml
60106324 v1

MANDEL & ADRIANO

INTELLECTUAL PROPERTY ATTORNEYS



SARALYNN MANDEL
SARAH B. ADRIANO*
55 S. LAKE AVENUE, SUITE 710
PASADENA, CA 91101
PHONE (626) 395-7801
FAX (626) 395-0694
*Admitted in New York Only

September 19, 2003

U.S. Mail – Return Receipt Requested

Dr. Charles L. Sawyers
11-934 Fator Building
UCLA-Hematology/Oncology
10833 Le Conte Avenue
Los Angeles, California 90095

Dr. Karen A. Klein
11-934 Fator Building
UCLA-Hematology
10833 Le Conte Avenue
Los Angeles, California 90095

Dr. Owen N. Witte
HHMI/UCLA
5-720 MRL
675 Charles E. Young Drive South
Box 951622
Los Angeles, California 90095-1662

Dr. Robert E. Reiter
UCLA Urology Department
Box 951738
650 Circle Drive South
Room #66-134
Los Angeles California 90095-1738

Re: Charles L. Sawyers et al., entitled "METHODS OF SIMULATING HUMAN PROSTATE CANCER PROGRESSION," U.S. Serial No. 10/062,684 filed January 30, 2002, which is a continuation of U.S. Serial No. 09/567,202 filed May 8, 2000, now issued U.S. Patent No. 6,365,797, issued on April 2, 2002, which is a divisional of U.S. Serial No. 08/951,143 filed October 15, 1997, now issued U.S. Patent No. 6,107,540, issued on August 22, 2000, which was a CIP of U.S. Serial No. 08/732,676 filed October 15, 1996, now abandoned; Your Ref. 96-540-5 (Sawyers); M&A Ref. 30435.53USD3

Dear Drs. Sawyers, Klein, Witte and Reiter:

I enclose a copy of the above-referenced U.S. Patent application and an original Combined Declaration and Power of Attorney. Please review the enclosed application then sign and date the Combined Declaration and Power of Attorney where indicated, in black ink. Please return the Combined Declaration and Power of Attorney to us by facsimile, and the originals by mail to the above address by **October 18, 2003**.

Failure to return the executed documents by the **October 18, 2003** date will be viewed as a refusal to sign.

Dr. Charles L. Sawyers
Dr. Karen A. Klein
Dr. Owen N. Witte
Dr. Robert E. Reiter
September 19, 2003
Page 2

If you have any questions or comments, please contact us. Meanwhile, thank you for your cooperation.

Sincerely,



Richelle Ann Domingo
Legal Assistant

/rapd

Enclosure

cc: Lorelei de Larena, Esq. (w/ encl.)
Ms. Linda Stevenson (w/ encl.)
Timothy Lithgow, M.D., J.D. (w/ encl.)
Sarah B. Adriano, Esq. (w/o encl.)
Stephanie Hsieh, Esq. (w/o encl.)

C:\Documents and Settings\rdomingo\My Documents\30435\53usd3\corres\ltr inventors re-execute dec.doc

TOWNSEND
and
TOWNSEND
and
CREW



Direct: (415) 273-4758
kib@townsend.com

November 5, 2003

Via FedEx

Dr. Karen A. Klein
174 Denslow Avenue
Los Angeles, CA 90049

Re: U.S. Patent Applications Serial Nos. 10/062,684, 10/062,738 and 10/062,925
filed January 30, 2002 for
METHODS OF SIMULATING HUMAN PROSTATE CANCER PROGRESSION;
MICE MODELS OF HUMAN PROSTATE CANCER PROGRESSION; and
METHODS OF ASSESSING THE EFFECT OF A GENE OF INTEREST ON HUMAN
PROSTATE CANCER PROGRESSION
Inventors: Charles L. Sawyers, Karen A. Klein, Owen N. Witte
and Robert E. Reiter
UC Case no. 1996-540-5, -8 and -7
Our file no. 02307O-1413-13US, -16US and -15 US

Dear Dr. Klein:

Responsibility for prosecution of the above patent applications has recently been transferred by the assignee, the Regents of the University of California, to our firm from the Mandel & Adriano firm.

We note that revised Declarations have been required by the examiner, but the forms for your signature were addressed to your old work address at the UCLA Hematology lab. We have received signed Declarations back from your co-inventors and would like to file all documents with the U.S. Patent and Trademark Office by **November 16, 2003**. Please sign and return your three Combined Declaration and Power of Attorney forms to us by that date.

If you have any questions, please telephone me. Thank you.

Very truly yours,

A handwritten signature in black ink, appearing to read "Jean M. Lockyer".

Jean M. Lockyer, Ph.D.
Patent Agent

JML/mcd
Enclosure

60075688 v1



FedEx Express
Customer Support Trace
3875 Airways Boulevard
Module H, 4th Floor
Memphis, TN 38116

U.S. Mail: PO Box 727
Memphis, TN 38194-4643

Telephone: 901-369-3600

11/10/2003

Dear Customer:

Here is the proof of delivery for the shipment with tracking number **790953528160**. Our records reflect the following information.

Delivery Information:

Signed For By: K.KLEIN



Delivery Location: 174 DENSLOW AVE.

Delivery Date: November 6, 2003

Delivery Time: 1015

Shipping Information:

Tracking No: 790953528160

Ship Date: November 5, 2003

R cipient:
KAREN KLEIN

174 DENSLOW AVE.
LOS ANGELES, CA 90049
US

Shipper:
MALINDA DAGIT
TOWNSEND & TOWNSEND & CREW
2 EMBARCADERO CTR FL 8
SAN FRANCISCO, CA 941113833
US

Shipment Reference Information:

02307K-1413-13US

Thank you for choosing FedEx Express. We look forward to working with you in the future.

FedEx Worldwide Customer Service
1-800-Go-FedEx®
Reference No.: R2003111000105244893

Handwritten notes:
Received
Sent to
Car...
11/10/03

TOWNSEND
and
TOWNSEND
and
CREW



Direct: (415) 273-4758
klb@townsend.com

November 13, 2003

Certified Mail
Return Receipt Requested

Dr. Karen A. Klein
174 Denslow Avenue
Los Angeles, CA 90049

Re: U.S. Patent Applications Serial Nos. 10/062,684, 10/062,738 and 10/062,925
filed January 30, 2002 for
METHODS OF SIMULATING HUMAN PROSTATE CANCER PROGRESSION;
MICE MODELS OF HUMAN PROSTATE CANCER PROGRESSION; and
METHODS OF ASSESSING THE EFFECT OF A GENE OF INTEREST ON HUMAN
PROSTATE CANCER PROGRESSION
Inventors: Charles L. Sawyers, Karen A. Klein, Owen N. Witte
and Robert E. Reiter
UC Case no. 1996-540-5, -8 and -7
Our file no. 02307O-1413-13US, -16US and -15 US

Dear Dr. Klein:

Enclosed are copies of our letter and enclosures sent to you via FedEx on November 5th. It is not clear that you received this package, as another individual's signature was on the FedEx form.

If you have any questions, please telephone me. We would appreciate it if you could return these by the next due date, **November 25th**. Thank you.

Very truly yours,

A handwritten signature in black ink, appearing to read "Jean M. Lockyer".

Jean M. Lockyer, Ph.D.
Patent Agent

JML/mcd
Enclosures

60082339 v1



Is your RETURN ADDRESS completed on the reverse side?	SENDER: <ul style="list-style-type: none">■ Complete items 1 and/or 2 for additional services.■ Complete items 3, 4a, and 4b.■ Print your name and address on the reverse of this form so that we can return this card to you.■ Attach this form to the front of the mailpiece, or on the back if space does not permit.■ Write "Return Receipt Requested" on the mailpiece below the article number.■ The Return Receipt will show to whom the article was delivered and the date delivered.		I also wish to receive the following services (for an extra fee): 1. <input type="checkbox"/> Addressee's Address 2. <input checked="" type="checkbox"/> Restricted Delivery Consult postmaster for fee.	
	3. Article Addressed to: Karen Klein 174 Denslow Ave. Los Angeles, CA 90045		4a. Article Number P 185 076 810	
	5. Received By: (Print Name) Sean Turner		4b. Service Type <input type="checkbox"/> Registered <input checked="" type="checkbox"/> Certified <input type="checkbox"/> Express Mail <input type="checkbox"/> Insured <input type="checkbox"/> Return Receipt for Merchandise <input type="checkbox"/> COD	
	6. Signature: (Addressee or Agent) <input checked="" type="checkbox"/> Sean Turner		7. Date of Delivery 11/15/03	
		8. Addressee's Address (Only if requested and fee is paid)		

PS Form 3811, December 1994

Domestic Return Receipt

Thank you for using Return Receipt Service.

TOWNSEND
and
TOWNSEND
and
CREW



San Francisco, CA

November 18, 2003

FedEx

Dr. Karen A. Klein
174 Denslow Avenue
Los Angeles, CA 90049

Re: U.S. Patent Applications Serial Nos. 10/062,684, 10/062,738 and 10/062,925
filed January 30, 2002 for
METHODS OF SIMULATING HUMAN PROSTATE CANCER PROGRESSION;
MICE MODELS OF HUMAN PROSTATE CANCER PROGRESSION; and
METHODS OF ASSESSING THE EFFECT OF A GENE OF INTEREST ON HUMAN
PROSTATE CANCER PROGRESSION
Inventors: Charles L. Sawyers, Karen A. Klein, Owen N. Witte
and Robert E. Reiter
UC Case no. 1996-540-5, -8 and -7
Our file no. 02307K-1413-13US, -16US and -15 US

Dear Dr. Klein:

The three above applications are children of a parent application. Enclosed is a copy of that parent and the original Declaration that you signed at the time of filing. As I mentioned in our telephone conversation, the examiner has required us to submit a substitute Declaration in each of the children applications to correct a typographical error on the first page of the original Declaration.

Enclosed is pre-paid FedEx envelope for your convenience in returning your signed Declarations to us. Thank you.

Very truly yours,

A handwritten signature in black ink, appearing to read "Jean M. Lockyer".

Jean M. Lockyer, Ph.D.
Patent Agent

JML/mcd
Enclosures

60085391 v1

From: Malinda Dagit (415)576-0200
Townsend and Townsend and Crew LLP
Two Embarcadero Center
8th Floor
San Francisco, CA, 94111

REVENUE BARCODE



FedEx.

To: Karen Klein (415)273-4373

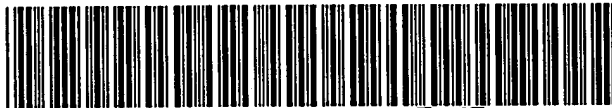
174 Denslow Ave.

Los Angeles, CA, 90049

Ref: 02307K-1413-13US

SHIP DATE: 18NOV03
WEIGHT: 1 LBS

RELEASE# 3785346



DELIVERY ADDRESS BARCODE(FEDEx-EDR)

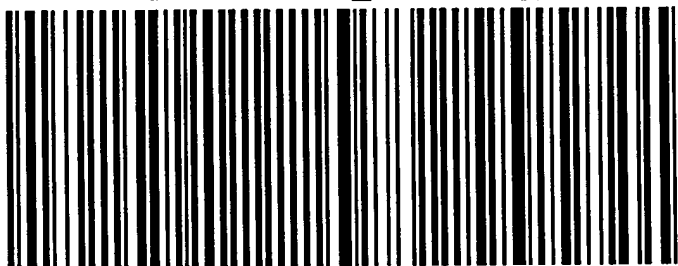
TRK # 7910 6700 1684 6201

FedEx PRIORITY OVERNIGHT

LAX

90049-CA-US

WZ SMOA

WED
A2Deliver by:
19NOV03

Shipping Label: Your shipment is complete

[Cancel shipment](#) [Edit shipment information](#) [Process another shipment](#) [Repeat last shipment](#)

1. Use the 'Print' feature from your browser to send this page to your laser or inkjet printer.
2. Fold the printed page along the horizontal line.
3. Place label in shipping pouch and affix it to your shipment so that the barcode portion of the label can be read and scanned.

Warning: Use only the printed original label for shipping. Using a photocopy of this label for shipping purposes is fraudulent and could result in additional billing charges, along with the cancellation of your FedEx account number.

Use of this system constitutes your agreement to the service conditions in the current FedEx Service Guide, available on fedex.com. FedEx will not be responsible for any claim in excess of \$100 per package, whether the result of loss, damage, delay, non-delivery, misdelivery, or misinformation, unless you declare a higher value, pay an additional charge, document your actual loss and file a timely claim. Limitations found in the current FedEx Service Guide apply. Your right to recover from FedEx for any loss, including intrinsic value of the package, loss of sales, income interest, profit, attorney's fees, costs, and other forms of damage whether direct, incidental, consequential, or special is limited to the greater of \$100 or the authorized declared value. Recovery cannot exceed actual documented loss. Maximum for items of extraordinary value is \$500, e.g. jewelry, precious metals, negotiable instruments and other items listed in our Service Guide. Written claims must be filed within strict time limits, see current FedEx Service Guide.